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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,049	05/29/2001	Kai Nyman	NC28444A	7666
4955	7590	10/12/2005	EXAMINER	
WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP BRADFORD GREEN BUILDING 5 755 MAIN STREET, P O BOX 224 MONROE, CT 06468			DAVIS, ZACHARY A	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,049

Applicant(s)

NYMAN ET AL.

Examiner

Zachary A. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. A Petition to Revive the present application, with amendment, was received on 15 July 2005. Claims 1, 13, 15, 17, 18, 21-24, 31, 35, and 37 have been amended. Claim 36 has been canceled. No new claims have been added. Claims 1-35 and 37 are currently pending in the present application.

Drawings

2. The objections to the drawings are withdrawn in light of the replacement sheets submitted. For future notice, the Examiner notes that although Applicant has provided annotated sheets showing the changes in red ink, it is not possible to distinguish the red ink from the black after the papers have been scanned into the Image File Wrapper system.

Response to Arguments

3. Applicant's arguments filed 15 July 2005 have been fully considered but they are not persuasive.

Claims 1-10, 13-22, 25-35 and 37 were rejected under 35 U.S.C. 102(e) as anticipated by Turtiainen, US Patent 6430407, and Claims 11, 12, 23, and 24 were rejected under 35 U.S.C. 103(a) as unpatentable over Turtiainen in view of Lightman et

al, US Patent 6711414. In reference to independent Claims 1, 13, 25, 30, 35, and 37, Applicant first argues that Turtiainen is directed to solving a different problem from that of the present application. Applicant further states that the objective of the present application is to avoid the need for separate SIMs for multiple GSM devices, or from having to use the same SIM alternately in the multiple devices; however, the Examiner notes that one of the disclosed advantages of Turtiainen's system is that "The user is freed from carrying a separate authentication device (PAD) or many authentication devices" (see column 5, lines 10-33, especially lines 20-21). This is clearly analogous to Applicant's stated objective.

Applicant further argues that the claimed signal interchanges are not disclosed in the Turtiainen reference, and that "Rather, the user 22 is utilized with the knowledge that the user has possession of and which forms is an integral of the process illustrated by Turtiainen". The Examiner fails to appreciate this argument.

In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which Applicant relies (i.e., that there is no IMSI received by Turtiainen's terminal device, there is no challenge received by the terminal device and sent to the mobile phone, and that there is no secret sent from the mobile phone to the terminal) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the Examiner believes that Turtiainen does indeed disclose the claimed step of receiving a subscriber identity (column 8, lines 43-

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53, where messages used for the authentication include receiver identification; column 9, lines 26-37, where the registers receive identification information; see also column 11, lines 47-50), noting that Turtiainen additionally discloses an IMSI (column 9, lines 26-37). The Examiner also believes that Turtiainen does disclose that a challenge is received (column 10, lines 22-27, where the challenge is received from the authenticating application) and that a secret is received in response to the challenge (see, for example, column 10, lines 27-38; see also column 9, line 38-column 10, line 9).

Regarding the nature of the connections disclosed by Turtiainen, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Therefore, for the reasons detailed above, the Examiner maintains the rejections as set forth below.

Double Patenting

4. The provisional statutory and nonstatutory double patenting rejections are withdrawn in light of the abandonment of the copending application (09/858,264).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-10, 13-22, 25-35, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Turtiainen, US Patent 6430407.

In reference to Claim 1, Turtiainen discloses a method for authenticating a client to a communication system including receiving a subscriber identity from a mobile station (column 9, lines 29-37 and 45-49) where a mobile telecommunication network is separate from the communication system to which the client is being authenticated (column 8, lines 1-7), sending the subscriber identity, receiving a challenge and a secret, and using a response to the challenge and the secret to authenticate the client (column 10, lines 22-39).

In reference to Claims 2, 3, and 8, Turtiainen further discloses receiving a PIN (column 10, lines 26-30) and encrypting the PIN (column 9, line 66-column 10, line 9).

In reference to Claims 4 and 5, Turtiainen further discloses encrypting and transmitting the response (column 10, lines 6-9).

In reference to Claims 6 and 7, Turtiainen further discloses that the transmissions and receptions are performed wirelessly (column 6, lines 18-25).

In reference to Claims 9 and 10, Turtiainen further discloses that the wireless transmissions can use an infrared signal or a radio signal (column 10, lines 51-55).

In reference to Claim 25, Turtiainen discloses a method including retrieving and sending a subscriber identity (column 9, lines 29-37 and 45-49), receiving a challenge, and generating and sending a secret in response to the challenge (column 10, lines 22-39).

In reference to Claims 26, 27, 28, and 29, Turtiainen further discloses receiving a request containing an encrypted PIN and confirming the PIN (column 9, line 66-column 10, line 9; column 10, lines 22-39).

Claims 13-22 and 30-34 are apparatus claims corresponding substantially to the methods of Claims 1-10 and 25-29, respectively, and are rejected by a similar rationale.

Claim 35 is directed to software implementations of the method of Claim 7, and is rejected by a similar rationale. Similarly, Claim 37 is directed to a software implementation of the method of Claim 25, and is rejected by a similar rationale.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11, 12, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turtiainen in view of Lightman et al, US Patent 6711414.

In reference to Claims 11 and 12, Turtiainen discloses everything as applied to Claim 8 above. Turtiainen also discloses that the wireless transmissions can have any "suitable operational connection" (column 10, lines 53-54); however, Turtiainen does not explicitly disclose the use of a low power radio signal or an acoustic signal for the wireless transmissions.

Lightman discloses a wireless communication apparatus that can transmit wireless signals using an infrared signal, a Bluetooth (low power radio) signal, a radio frequency signal, or an acoustic signal (column 6, lines 36-53). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Turtiainen to use a low power radio signal or acoustic signal for the wireless transmissions, in order to allow the wireless communication devices to easily transmit to and receive from other devices, and to allow the wireless devices to interact with other devices and their surroundings (see Lightman, column 3, lines 19-28).

Claims 23 and 24 are apparatus claims corresponding substantially to the methods of Claims 11 and 12, and are rejected by a similar rationale.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ZAD
zad

E. L. Moise
EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER